

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Houghton et al.	
Application No.: 09/996,128	Group Art Unit: 1642
Filed: 11/27/2001	Examiner: A Harris
Title: Compositions for Treatment of Melanoma and Method of Using Same	Confirmation No: 3698
Attorney Docket No.: MSK.P-026-3	
Customer No.: 52334	

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

PETITION UNDER 37 CFR 1.144 FOR REVIEW OF RESTRICTION REQUIREMENT

Dear Sir:

Applicants hereby petition pursuant to 37 CFR 1.144 for review of the restriction requirement in the above-referenced application and request a direction to the Examiner to modify the restriction such that election of two sequences, as opposed to only 1 is permitted, consistent with the provisions in the MPEP.

MPEP § 803.04 (August 2006) indicates that election of up to ten species of oligonucleotide per application is reasonable even in the context of a composition claim, in accordance with the partial waiver of the single invention provisions of 37 CFR 1.141. In the present case, Claim 24, which specifically refers to Seq. ID Nos: 1 as being used in the claimed method has been indicated to be allowable, but claim 25 which refers to Seq. ID No. 2 in the same method is said to be a different invention because it is a different sequence. Thus, Applicants have been required to elect a single oligonucleotide in this application.

The Examiner has provided no reasoning as to why election of two sequences (a number less than 10) was not originally allowed. Specifically, the Examiner has not shown that this is an "exceptional case" in which "the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten." MPEP § 803.04. Indeed, in the restatement of the restriction requirement in the Office Action mailed December 27, 2006, the

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Examiner has basically stated that one sequence is within the scope of "up to ten" and offered no additional reasoning. As such, the restriction requirement fails to comport with the standard practice of the Office and a direction should be made to the Examiner to consider claim 25 on the merits.

Furthermore, claims 26 and 27 refer to the vectors of Seq ID Nos. 1 and 2 *per se*. These were treated as unrelated inventions in the restriction requirement mailed June 25, 2004, even though only two sequence were involved. Applicants requested reconsideration of this restriction in a paper filed July 26, 2004, on the basis that no search burden was involved. In response, the examiner made a general statement that the search burden in literature as opposed to patents was different but did not provide any specifics as to why this would be the case.

The vectors of claims 26 and 27 are complex structures intended for the specific purpose achieved in the method claims of this invention. The Examiner has not indicated any other reason for making such a construct other than expression of the specified protein in a cell. Applicants submit that there is no actual showing of a search burden to consider these claims in the same application as the method claims, and that restriction would be against the public interest by allowing separate patents to issue on a vector and the use of that vector.

For these reasons, direction to the Examiner to consider claims 25-27 on the merits is requested.

Respectfully submitted,



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